

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

SEP 30 2002

Ex parte JOSEPH P. KRONZER and JAMES F. DYRUD

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Appeal No. 2001-2429
Application No. 08/661,834

ON REQUEST FOR REHEARING

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

This case comes before us again on request by the appellants for rehearing of
our decision of March 19, 2002, wherein we sustained the examiner's rejection of
claims 25-37 under 35 U.S.C. § 103 as being unpatentable over Dyrud.¹

We GRANT THE REQUEST FOR REHEARING AND REMAND THE
APPLICATION TO THE EXAMINER.

¹We did not sustain the rejection of claims 25-37 as being indefinite under 35 U.S.C. § 112,
second paragraph.

OPINION

The appellants' invention relates to a fibrous filtration mask. The basis upon which we sustained the examiner's rejection under 35 U.S.C. § 103 in our decision of March 19, 2002, was that the test evidence provided by the appellants in their specification, which was relied upon to distinguish the claims over Dyrud, failed to support their assertion that filtration masks produced by the Dyrud method did not have a surface fuzz value exceeding 8.0, as required by the appellants' claims. This conclusion was based upon the fact that the appellants' data was presented as being an "average" of six shells tested which, in our words,

"[i]n the absence of evidence to the contrary, . . . gives rise to the conclusion that while the fuzz value of some of the six shells tested was less than 8.0, the fuzz value of at least one of the others was greater than 8.0. This being the case, the appellants' own test data shows that at least some of the shells produced by the Dyrud hot forming process can be expected to have a fuzz value greater than 8.0. (Pages 8 and 9).

In their Request for Rehearing, the appellants have asserted that our decision is not correct on four bases. One of these is that, although not so stated in the test data reproduced in the specification, all of the six shells made by the Dyrud process had a fuzz value of exactly 8.0, that is, the "average" achieved in the tests did not include any values in excess of 8.0. In support of this, the appellants have filed with the Request

for Rehearing copies of pages from the laboratory notebook containing the test data for Example 26 (the Dyrud process), along with a declaration from Joseph P. Kronzer attesting to the fact that this was the relevant data. The appellants also stated that the declaration and data were not earlier provided "because the Board's reasoning differs from the Examiner's reasoning" (Request, page 2).

Upon reconsideration, we agree with the appellants that our reasoning in affirming the examiner's rejection differed significantly from that set out by the examiner in the statement of the rejection. This being the case, our decision of March 19, 2002 is modified in the following manner:

The Board's affirmation of the examiner's rejection of claims 25-37 as being unpatentable over Dyrud under 35 U.S.C. § 103 is denominated as a new ground of rejection under 37 CFR 1.196(b).

A new rejection under 37 CFR 1.196(b) now having been entered by the Board, it would now appear that the declaration and supporting evidence submitted by the appellants with their Request for Rehearing have been timely filed and should be entered into the record and their contents considered as a response permitted by 37 CFR § 1.196(b)(1). In this regard, we observe that this evidence has been submitted to support the appellants' contention that the Dyrud process would not produce a shell having a fuzz value in excess of 8.0.

However, the above action necessitates consideration of another matter.

Claim 25 is so worded as to present some of the limitations as being optional. In the final rejection, the examiner considered together all of the limitations recited in claim 25, including those that were optional. This apparently was grounded in his determination that the evidence presented by the appellant in the specification regarding the 8.0 fuzz value, which appears to be the most comprehensive limitation in the claim, was not persuasive that the claim was patentable over Dyrud. Having reopened this matter in response to the request for rehearing, and in view of the submission of the new evidence by the appellants, it appears to us that the patentability of claim 25 should be considered anew by the examiner. Central to this conclusion is our belief that claim 25 includes within its scope four inventions of differing scope by virtue of the fact that in paragraph (b), which sets forth the structure of the fibrous layer, the staple fibers are presented "optionally" and the 85 weight percentage or greater of bicomponent fibers is "with the proviso that" From our perspective, the following four different face masks are within the scope of claim 25 by virtue of the language of subparagraph (b), each in combination with the means for securing the mask to the face of the wearer set forth in subparagraph (a):

- (1) A non-woven fibrous layer attached to the securing means and containing (i) at least about 40 wt. % thermally bonding fibers based on

the weight of the fibers in the non-woven fibrous layer, at least 10 wt. % of the fibers in the non-woven fibrous layer being bicomponent fibers, the non-woven fibrous layer being molded in a cup-shaped configuration and having a surface fuzz factor of not less than 7.5 after being subjected to a surface fuzz abrasion test.

(2) The non-woven fibrous layer recited in (1) further comprising staple fibers.

(3) The non-woven fibrous layer recited in (1) further comprising staple fibers and wherein the bicomponent fiber content is 85 weight percent or greater and the surface fuzz factor exceeds 8.0.

(4) The non-woven fibrous layer recited in (1) wherein the bicomponent fiber content is 85 weight percent or greater and the surface fuzz factor exceeds 8.0.

A like situation is presented by independent claim 32, wherein by virtue of the "proviso" concerning the weight percent of bicomponent fiber, two different fibrous layers are recited.

From our perspective, it would appear that claim 25 would be unpatentable if the prior art anticipated or rendered obvious the subject matter recited in subparagraph (1) above, which is the broadest of the variants within the scope of the claim. However, the examiner has not considered the claim in this fashion and, of course, the appellants have not had the opportunity to present arguments in opposition to such a position.

In view of the foregoing modification to our decision in response to the Request for Rehearing, and the matter raised in the preceding paragraphs, this application is remanded to the examiner for the following action:

- (1) To consider the request for rehearing and the declaration by Mr. Kronzer with the attached notebook pages as a response under 37 CFR § 1.196(b)(1).
- (2) To evaluate the standing rejection of claims 25-37 as being unpatentable over Dyrud under 35 U.S.C. § 103 in view of this response.
- (3) To evaluate the patentability of the claims in the light of the matter raised above by the Board that four alternative variants of differing scope are within the scope of independent claim 25 and two in independent claim 32.
- (4) Such further action as the examiner may consider to be appropriate.

Since the appellants have effectively elected to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If prosecution before the examiner does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING GRANTED -- 37 CFR § 1.196(b);
REMANDED TO THE EXAMINER



IRWIN CHARLES COHEN
Administrative Patent Judge



NEAL E. ABRAMS
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

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